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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,293	12/17/1999	ROSS S. TSUGITA	247/062	2206

34263 7590 02/26/2004

O'MELVENY & MEYERS
114 PACIFICA, SUITE 100
IRVINE, CA 92618

EXAMINER

MENDEZ, MANUEL A

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/467,293

Applicant(s)

TSUGITA ET AL.

Examiner

Manuel Mendez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

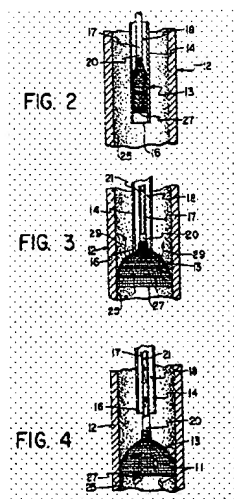
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barbut, et al., in view of Miller, et al., and/or Wholey, et al.**

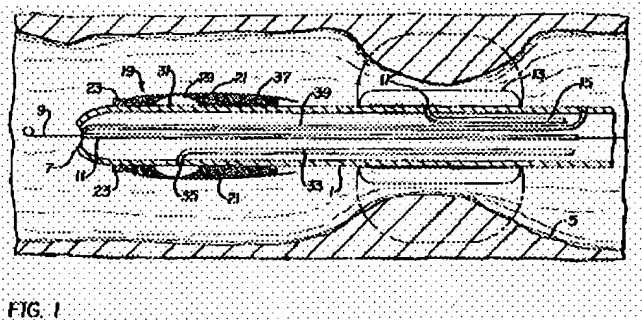
Barbut, et al., discloses the steps of inserting the distal end of a cannula into an aorta, inserting a filter through a lumen of the cannula, deploying a filter/occluder. Barbut, et al., does not disclose the step of inserting a filter through a lumen of the cannula and past the distal end of the cannula. However, that particular step is conventional as demonstrated by the teachings of Miller, et al.



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In figures 2-4, Miller, et al., demonstrates the conventionality of embodiments where the filter is introduced via lumen and is deployed past the distal end of the cannula.

Moreover, enhancing figures 2-4, with an expandable or occluder is another conventional design in the art as evidenced by the teachings of Wholey, et al.

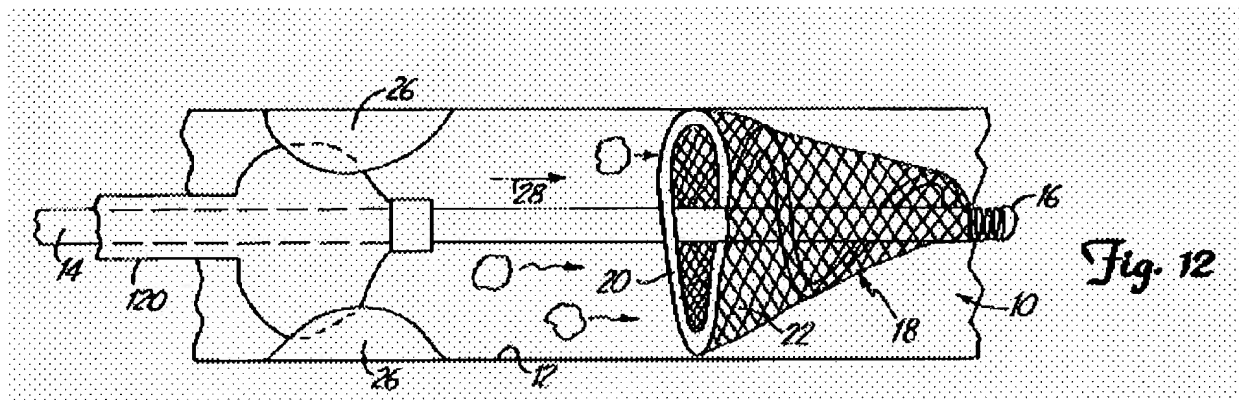


In figure 1, Wholey, et al., shows that the use of an occluder in combination with a deployable filter is well known in the art. Based on this evidence, the addition of an occluder to the catheter enhances the capabilities of the catheter/cannula system. Conclusively, for a person of ordinary skill in the art, the modification of the **Barbut, et al.** cannula with a filter that is deployable past the distal end of the cannula, would have been considered an obvious design alternative.

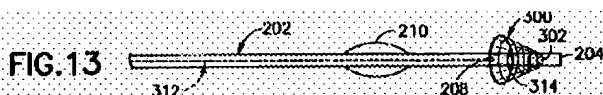
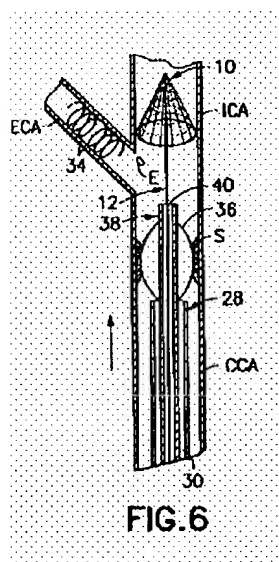
SECOND REJECTION

Claims 19 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **USSR 764684, in view of Daniel, et al., and/or Kerr.** USSR 764684 shows in figures 5 and 6, the insertion of the distal end of a catheter/cannula apparatus into an aorta, the catheter/cannula system having a filter that is deployable upon introduction into the heart. The cited foreign patent does not disclose an occluder in the outer wall

of the catheter and a lumen-deployable filter. However, the use of a filter in combination with an occluder is conventional in the art as evidenced by Daniel, et al., and Kerr.



In figure 12, Daniel, et al., shows an occluder in the outer wall of the catheter and a lumen-deployable filter. Additionally, in figures 6 and 13 below, Kerr also demonstrates the conventionality of using an occluder in the outer wall of the catheter and a lumen-deployable filter in a catheter cannula apparatus.



Based on the persuasive evidence presented above, for a person of ordinary skill in the art, the modification of the catheter presented in USSR 764684 with an occluder

in the outer wall of the catheter and a lumen-deployable filter would have been considered an obvious design choice. Clearly, such enhancement would have expanded the capabilities of the catheter/cannula apparatus.

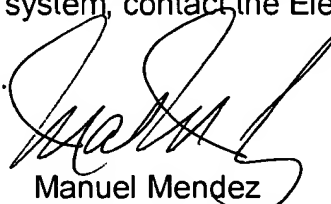
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 703-308-2221. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuel Mendez
Primary Examiner
Art Unit 3763

MM